



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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#9/A
9-5-02
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In re application of

Tetsuro KAWAHARA, *et al.*

Appln. No.: 09/630,777

Group Art Unit: 1774

Confirmation No.: 8005

Examiner: Lawrence D. FERGUSON

Filed: August 2, 2000

Attorney Docket No.: Q60204

For: ARTICLE HAVING PHOTOCATALYTIC ACTIVITY

**PETITION TO WITHDRAW THE
FINALITY OF OFFICE ACTION**

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

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Applicants submit that the final Office Action mailed June 6, 2002, improperly has been made final, and Applicants respectfully petition for the withdrawal of the finality of the Office Action.

A second or any subsequent action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by an applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement (IDS) (*see*, MPEP §706.07(a)). Conversely, a final rejection is improper where there is another new ground of rejection introduced by the Examiner which was not necessitated by (i) an applicant's amendment to the claims or (ii) information submitted in an IDS.

In the Action mailed June 6th, the Examiner sets forth a new ground of rejection which was not necessitated by either Applicants' amendments or information from an IDS.

Specifically, claim 1, as originally filed, was drawn to an article. Each of originally filed claims 2-9 depended from claim 1. The Examiner rejected claims 1-6 and claims 7-9 under §103(a) in an Action mailed December 14, 2001. The rejection of claims 1-6 was allegedly supported by Inoue *in view of* Nakanishi and the rejection of claims 7-9 was allegedly supported

REQUEST TO WITHDRAW FINALITY
U.S. Appln. No. 09/630,777

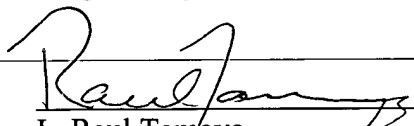
by Inoue *in view of* Nakanishi, WO '021 and EP '967.

In the response filed March 14, 2002, Applicants did not amend any of the claims. Instead, Applicants focused a traversing argument on the Examiner's concession that "EP '991 [Inoue] does not disclose an energy band gap" (Applicants refer to page 3, lines 1-2 of the Action mailed December 14th), and on the Examiner's reliance on JP '332 (Nakanishi) to cure the energy band gap deficiency of Inoue (Applicants refer to page 3, lines 3-6 of the December 14 Action).

The Examiner responded with an Action mailed June 6, 2002, wherein the §103 rejection of claims 1-6 allegedly supported by Inoue *in view of* Nakanishi and the §103 rejection of claims 7-9 allegedly supported by Inoue *in view of* Nakanishi, WO '021 and EP '967 were withdrawn. The withdrawn rejections were replaced with a new §103 rejection of claims 1-6 supported by Inoue alone and a new §103 rejection of claims 7-9 supported by Inoue *in view of* WO '021 and EP '967. The Examiner made the new Action a final Action.

The decision to make the June 6th Action a final Action was improper. Specifically, the §103 rejections therein, each of which no longer relies on Nakanishi, represent new grounds of rejection. Indeed, the new grounds of rejection are clearly set forth at page 3, lines 4-11 and page 4, paragraph No. 7 of the June 6 Action, wherein the Examiner repeats that "EP '991 [Inoue] does not disclose an energy band gap", but this time relies on an inherency argument to cure the deficiency of Inoue. Because the inherency argument, set forth at lines 5-11 of page 3, is new to Applicants, and Applicants neither amended the claims nor submitted information in an IDS to necessitate the switch from Nakanishi to the inherency argument, Applicants respectfully request that the finality of the Office Action be withdrawn.

Respectfully submitted,


L. Raul Tamayo
Registration No. 47,125

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
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